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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Marvin L Schilling & Richard D. Farfard

Serial No: 09/964,120

Filed: 09/25/01

For: Method for producing Biologically Active Products

Group Art Unit:1616 Examiner: Sharmila S Gollamudi

Hon. Commissioner of Patents
& Trademarks,
Washington, D.C. 20231

Sir,

RESPONSE F

In response to the Office Action dated March 1, 2004 please cancel claims 33 to 41 and add claims 42 to 51 in the subject application as set forth in the attached claim amendment.

The claims have been amended in response to the 35 USC 112 objections raised by the examiner in the final action in the subject application with the exception of the two points discussed below. The examiner believes it to be unclear how a product undergoing dehydration can be recovered in the original form. However the wording is to be believed clear that it is the collagen II protein that is recovered in the original form.

The language " at least 15 % by weight of the cartilage" is necessary to provide a basis for the percentage.

The examiner is further requested to clarify his rejection of claims 33-40 as being unpatentable over Moore in view of Ueno et al or in view JP '637 (a reference cited for the first time by the examiner in the final action after almost three years of prosecution) optionally in further view of Puppolo. It is not clear whether the examiner is rejecting the claims on the basis of a combination of two, three or four references. If separate grounds of rejection are involved then such should be separated in order to clearly state the issues on appeal.

Applicants submit the there is no motivation for the combination of these references. The examiner has ignored the requirement that in order to find such motivation the examiner cannot rely on hindsight and base his combination on some general assertion of knowledge in the prior art. These references all relate to different proteins, different methods of dehydration and different types of denaturization such that there is no basis to extend the teachings from one to the other. The examiner has ignored the mandate of the Federal Circuit Court of Appeals in the elements required to combine references as set forth in *In re Fine* 837 F.2d 12071, 5 USPQ2d 1596 (Fed. Cir., 1988) and in the more recent decision of that Court in *In re Lee* 277 F.3d 1338 61 USPQ2d 1430 (Fed. Cir., 2002), which clearly holds that some general allegation of knowledge in the art is inadequate to support a combination of references. *In re Lee* further states that there is a "myriad"(the Court's words) of decisions requiring specific motivation for a combination of references and not reliance on applicants' own teachings. The differences in the art disclosed in the cited references has been set forth in applicants' pervious responses.

Similar clarification of the rejection of claim 41 is requested. Again it is not clear whether the examiner is combining separate rejections or is rejecting the claim over a combination of three or four references.

Entry of the foregoing amendment is requested to place the claims in better condition for appeal.

Respectfully submitted,

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Certificate under 37 CFR 1.8

I hereby certify that a copy of the foregoing Response has been forwarded to Group Art Unit 1616 to the attention Examiner Sharmila S. Gollamudi by facsimile mail.

Date: 09-03-04 Signature